REMARKS

In the Final Office Action,[1] the Examiner disapproved of the title; objected to the replacement drawing as containing new matter, and maintained the rejection of claims 16-21 as unpatentable over U.S. Patent No. 4,669,730 to Small ("Small"). Each of these issues are discussed in the remarks below.

The Examiner also provided a reference, U.S. Patent No. 6,243,688 to Kalina ("Kalina") in response to Applicant's request for evidence supporting the Examiner's taking of Official Notice. However, the List of References Cited, which accompanied the Final Office Action, does not list Kalina. Instead, the List of References Cited lists U.S. Patent No. 6,248,688 to Wu et al. Applicant respectfully requests a corrected List of References Cited form that lists Kalina, as discussed in the May 2005 telephone conversation between the Examiner and Applicant's representative.

By this amendment, Applicant has amended claim 16. Claims 16-21 are currently pending.

A. New Title

In the Final Office Action, the Examiner disapproved of the title, but did not specify the reasons. See Final Office Action, page 2. By this amendment, Applicant has proposed a new title that is brief, descriptive, and technically accurate, as requested by the Examiner. Accordingly, Applicant respectfully requests withdrawal of the objection to the title. If the Examiner disapproves of the proposed new title, Applicant

[1] The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

respectfully requests that the Examiner provide reasons for objecting to the title or provide suggestions for a new title.

B. Replacement Drawing

In the Final Office Action, the Examiner disapproved of the replacement drawing "because it appears that it contains new matter in block 6 (set off alarm)." See Final Office Action, page 2. Applicant respectfully submits that the replacement drawing for Figure 1 does not contain new matter. Support for block 6 (set off alarm) may be found at least on page 4, lines 18-24, of the specification. Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings.

C. Claim Rejections

Applicant respectfully traverses the rejection of claims 16-21 under 35 U.S.C. § 103(a) as being unpatentable over Small. No *prima facie* case of obviousness has been established with respect to claims 16-21 for at least the reason that Small, taken alone or in combination with the Examiner's Official Notice or with Kalina, does not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th Ed., Rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements

must "be found in the prior art, not in applicant's disclosure." M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004).

For example, amended claim 16 recites, among other things, "wherein the number of times the random number generator is operated is proportional to the purchase amount."

Small discloses a system for promoting or encouraging the use of financial institution transacting devices, such as ATMs and Point of Sale terminals. See Small, col. 2, lines 40-51. Small further discloses that a prize number is computer-generated each time a user inserts a debit card into an ATM or Point of Sale terminal. See Small, col. 3 lines 30-54. Thus, regardless of a purchase amount, a prize number is generated only once for each debit card transaction. Generating a single prize number per transaction does not constitute "wherein the number of times the random number generator is operated is proportional to the purchase amount," as claimed.

Kalina, relied on for its disclosure of investing a dollar amount at an investment firm on behalf of a customer to encourage certain customer behavior, fails to cure the deficiencies of Small. Thus, the references do not teach or suggest each and every element recited in the claims and Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 16. Claims 17-21 depend from and add additional features to independent claim 16 and are therefore allowable for at least the reasons set forth above.

Furthermore, claim 16 recites, among other things, "adding a percentage of said purchase amount to a jackpot total associated with the electronic data manipulation system." The Examiner properly observed that Small fails to disclose this element of

claim 16, but maintained taking of Official Notice to cure the deficiency of Small. See Final Office Action, page 2 and pages 6-7. In the Response to Applicant's Arguments section of the Final Office Action, the Examiner cited Kalina as evidence to support the Official Notice. See Final Office Action, page 2. However, Applicant respectfully submits that the Examiner failed to fully respond to Applicant's request for evidence to support the Official Notice. For example, the Examiner maintained that it is "common practice" to give an incentive, such as a percentage savings, to a customer for volume purchases (see Final Office Action, page 7), but provided no evidence that this teaching is well known. Therefore, Applicant requests evidence, such as an affidavit, that giving an incentive, such as a percentage savings, to a customer for volume purchases is well known in the art.

Moreover, assuming *arguendo* the Official Notice can be supported by evidence, Applicant respectfully submits that such evidence does not constitute a teaching or suggestion of the claim element: "adding a percentage of said purchase amount to a jackpot total associated with the electronic data manipulation system."

For example, Kalina allegedly discloses "providing an incentive (dollar amount) to a customer for performing a particular task [by investing] . . . at an investment firm on behalf of the customer." See Final Office Action, page 2. Regardless of whether this is the case, investing on behalf of a customer does not constitute "adding a percentage of [a] purchase amount to a *jackpot total*," as claimed. Nor is the deficiency of Small cured by the Examiner's taking of Official Notice that it is common practice to give an incentive, such as a percentage savings, to a customer for volume purchases. Kalina and the personal knowledge relied on by the Examiner merely teach purchasing

investment vehicles or granting discounts to frequent or high volume customers. These teachings and suggestions simply do not constitute "adding a percentage of said purchase amount to a jackpot total associated with the electronic data manipulation system," which the Examiner conceded as lacking from the disclosure of Small. Accordingly, for this additional reason Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 16 and claims 17-21, which depend from and add additional features to independent claim 16.

Conclusion

Applicant respectfully points out that the Final Office Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. See e.g., Final Office Action, pages 2-3. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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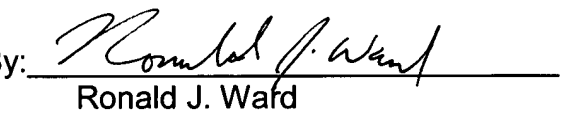
GARRETT & DUNNER, L.L.P.

Dated: July 5, 2005

By: 
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